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Docket No. F-8224

Ser. No. 10/823,919

REMARKS

Claims 3-20 are now pending in this application. Claims 1 and 2 are rejected.

Claims 1 and 2 are cancelled herein. New claims 3-20 are added.

The Examiner indicates that no Information Disclosure Statement has been filed in this application. The Examiner is reminded that the present application is a divisional. An Information Disclosure Statement and Citation List is filed herewith with references from application Ser. No. 10/823,863 which is also a divisional of the parent application. The parent application is application serial no. 10/111665, and is relied on for priority under 35 U.S.C. § 120 in the present application. Hence, all art considered in said parent application is to be considered in the present application.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 2 is rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention. Claim 2 is now cancelled and the newly present claims omit recitation of the term "hoop" which the Examiner has commented on. Therefore, the rejection of the claim is moot.

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CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1 and 2 are rejected as obvious over the Mishini reference under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

Claims 1 and 2 are now cancelled rendering their rejection moot. However, insofar as the subject matter of new claims 3-20 reflects in part that of the cancelled claims 1 and 2, and in the event the Examiner considers asserting the present rejection against the new claims, applicants submit the following remarks.

The Office Action states that determination of the patentability of a product-by-process claim turns on the whether the product produced is distinguishable of the prior art product. It is well established that product claims may include process steps to wholly or partially define the claimed product as a product of the recited process steps. See *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA1972). Each of the independent claims, claims 3 and 13, recite the process steps of the method claims of the parent application which have now issued in U.S. Patent number 6,878,173. To the extent these process limitations produce structure distinctions in the *product* over the prior art *products*, the distinctions must be given as much consideration as traditional product

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characteristics. Furthermore, "anticipation of invention set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from practice of processes disclosed in the references." *W.L. Gore Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 314 (Fed. Cir. 1983). And finally, in order to anticipate, the prior art reference must be enabling, i.e., it must contain within its four corners a sufficient description to enable one to practice the invention of the rejected claim without undue experimentation or inventive skills. *Akzo N.V. v. U.S. Intern. Trade Com'n*, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986). It is respectfully submitted that the process steps set forth in the pending claims produce a product which is structurally different from the prior art products, the difference being recited structurally in the pending claims, and that the prior art does not enable the production of such a product.

The Examiner cites the Mishini reference apparently for its discussion of compression of electrodes. The Mishini reference is directed to including a material in a battery in the form of member 105, as shown in Figs. 1a and 1b. The member 105 expands after being introduced into the battery and reaching operation temperature. The expansion acts to improved conduction by the compressing electrodes. Subsequent contraction of the member 105 when set to a non-operating temperature during recycling allows electrodes to be recycled by virtue of easy removal due to the lack of pressure on the electrode. Col. 7, lines 16-48. The reference has nothing to do with the formation of electrode plates using press

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working, removal of active material by ultrasonic vibrations to form a core substrate exposed section, and compression of the core substrate exposed section in order to form substantially true straight boundaries which exhibit a deviation from straight of no more than 0.2mm. These features are now recited in claim 3.

Claim 3 recites that the electrode plate of the battery is produced to have between the core substrate exposed section and the pressed portions, as related in the claims, "substantially true straight boundaries" and that these boundaries "exhibit a deviation from straight of no more than 0.2 mm." This feature is also recited in claim 13.

Claim 10 recites that the impregnation of the entire substrate before said work pressing forming said pressed portion is effected so as to produce an impregnation density variation of no more than 1.5% in said pressed portion after forming said battery electrode. This physical characteristic of the product is not taught by the applied reference. The feature is also present in claims 17 and 18.

Claims 11 and 13 each require that the method limitations produce the claimed physical result that active material residue is 4% or less in the core substrate exposed section. Such a residue level is not taught by the disclosure of the Mishina reference. In fact, the Meshina reference is completely silent concerning removing active material to produce an exposed substrate section from which the active material is substantially removed.

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Furthermore, claims 11 and 13 each require that the method limitations produce "a strength of said core substrate exposed section, after said removing of said active material and said compressing, being substantially equal to a strength of said pressed portions." This feature is not taught by the reference applied.

Dependent claims 4-9, 12, 14-16, 19 and 20 are added and are submitted as patentable over the cited art of record based on the subject matter cited therein in addition to the subject matter of their respective base claims discussed above.

FEES

No fees are believed due. If there is any fee due the USPTO is hereby authorized to it to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form
for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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